



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,821	06/18/2002	Robert Benjamin Franks	5897-000010	2406
27572 7590 04/28/2009 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303				
EXAMINER				
RUHL, DENNIS WILLIAM				
ART UNIT		PAPER NUMBER		
3689				
MAIL DATE		DELIVERY MODE		
04/28/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/030,821

**Applicant(s)**

FRANKS ET AL.

**Examiner**

Dennis Ruhl

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 26-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

Applicant's response of 12/9/08 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over [www.teas.uspto.gov](http://www.teas.uspto.gov) retrieved from the Internet Archive Wayback Machine of date October 12, 1999, January 10, 2000, and February 8, 2000 (hereinafter referred to as TEAS) in view of Lee (US 7,016,851 ) (hereinafter referred to as Lee) and further in view of Takano et al (US 6,434,580) (hereinafter referred to as Takano).

Referring to Claims 1-25:

TEAS discloses a method and system for processing transaction data relating to trademarks via at least one computer entity, said comprising:

a. displaying country data (page 5 (country) and page 8 (select country)) (the

Examiner notes that the Internet Archive retrieved a page from the 5/22/2001 date showing PrintTEAS=Version1.22:8/22/2000. However, the PTO Form 1478 shows a revision date of 9/98);

b. displaying classification data describing a list of goods and services classified into a plurality of different categories (pages 80-106 (page last modified on February 11,2000 (see page 110)));

c. displaying price data relating to at least one transaction price for performing a service in relation to the trademark (page 9 Fees; page 57 are your goods and/or services in more than one class; pages 28-35 last modified on May 26, 2000).

d. inputting individual items of classification data describing items of said list of goods and services classified into a plurality of different categories at the user interface (page 15 (listing of goods and services) and (International Class));

e. inputting data describing a trademark (page 13 Mark information), specifying an applicant (page 12 entity type), financial data of an account of a customer (page 18 Fee information), at the interface (pages 12-19);

f. inputting a user initiated confirmation message confirming the items of data (page 56 Verification and Signature)

- g. in response to receiving said input individual items of classification data, trademark data, applicant data, generating a confirmation of order display comprising displayed said input trademark data describing a trademark, said country data describing at least one country, applicant, items of said classification data describing selected items classified into different categories (page 19 validate form) (Examiner notes that this validate page would display a confirmation of all information inputted into the system); h. imputing a user generated confirm message confirming said input of said classification data, said confirm order constituting a legal acceptance of a transaction for said trademark (page 19 validate form; page 51 Filing Date and Filing Receipt; page 56; page 106 what is TEAS). compiling/filtering and storing trademark, classification, price, and applicant data in a database (page 109 depository library) and (page 18, "Declaration"));
- i. transmitting trademark data to a computer entity of an official trademark office as an electronic message (pages 1 e-TEAS);
- j. said computer entity configured to generate a trademark application order form, receive instruction data (page 1 e-TEAS);
- k. a search engine for searching and displaying data (page 1 SEARCH; pages 5-6);
- l. at least one communication means (Internet), plurality of memory storage

means (database for storing data) (page 5 Databases; page 109 Patent and Trademark Depository Library).

While TEAS is the USPTO electronic application system that can be used over the Internet, TEAS does not specifically disclose the structure of the system, wherein the system comprises a computer entity comprising a server computer entity and a client computer entity; said server transmitting data to a receiving client terminal, filtering/compiling data for storage in a database, and transmitting data to the receiving computer entity; at least one processor and at least one data processor; a web server configured to display and data and receive a webpage and other data; a user interface having a visual display device and a keyboard data entry means; displaying country data in which a trademark application may be filed; and automatically receiving an electronic filing receipt from an office trademark. Also not specifically disclosed is that the countries can be selected from a list of countries that are accompanied by icons that can be selected.

However, Lee discloses the structure of the system, wherein the system comprises a computer entity comprising a server computer entity and a client computer entity; said server transmitting data to a receiving client terminal, filtering/compiling data for storage in a database, and transmitting data to the receiving computer entity; at least one processor and at least one data processor; a web server configured to display and data and receive a webpage and other data; a user interface having a visual display device and a keyboard data entry means (Figures 1-3; col. 3, lines 42-46; col. 7, line 27

thru col. 8 line 11); and displaying country data in which a trademark application may be filed (col. 8, lines 19-37; Figure 3 jurisdiction).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the electronic trademark application system of TEAS the structure and ability to display country data in which the applicant may be filed as disclosed in Lee so that a party can file in multiple jurisdictions automatically in accordance with the jurisdiction requirements, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

TEAS does not disclose automatically receiving an electronic filing receipt from an office. However, Takano discloses an electronic filing receipt (col. 25, lines 45-50). 11. It would have been obvious to one of ordinary skill in the art to incorporate into the electronic trademark filing system of TEAS the electronic receipt taught in Takano so that one would have immediate proof that the document had been correctly received by the office to which it was being transmitted, thus having proof of filing and priority date, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

With respect to the countries being in the form of a list with icons, it is noted that TEAS does disclose the use of a pull down menu for selecting a country on page 5 of the portion of the TEAS relied upon. The language about "in which a trade mark application may be filed" is directed to non-functional descriptive material that does not

further limit the step of just displaying a list. TEAS discloses the use of a list in a computer interface where the user can select a country from the list. Not disclosed is the icons. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the list be associated with check boxes that the user can select by checking the box. This is a very well known method by which a user can select an option, whether it be on a paper form for a doctor visit where the user can check off symptoms they may have, or it could be an electronic format that has boxes that can be checked by a user. To a large extent, the choice of what manner by which the system will accept input is a matter of obvious choice to one of ordinary skill in the art. The use of a list of options with associated check boxes that can be selected by a user, which is represented in applicant's figure 17, is obvious to one of ordinary skill in the art. The prior art teaches having the country selection be by way of electronic pull down menu of a selectable list. The difference of having icons to check, which can simply be boxes to select, would have been obvious to one of ordinary skill in the art. The Examiner notes the following as to applicant's claim limitations.

As to claims 1-8, the invention is directed to a method of processing transaction data relating to trademarks. Transaction data relating to trademarks can be almost any kind of data.

As written, applicant's claims merely display data, allow a user to input data at a user interface, generate and send/transmit a message/data and receive data.



The system comprises at least one processor, at least one communications means, memory/databases, a user interface, a search engine, wherein the system can send and receive data, display a web page. Moreover, generating a confirmation message confirming said data can be simply presenting the page back to the user entering data to allow them to verify that all of the information is present and correct. This is done on a daily basis when information is being submitted over the Internet.

Moreover, most of the data being displayed, inputted, received, transmitted, etc. is non-functional descriptive data. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981 ).

However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004).

Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 21061V b I(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

4. Applicant's arguments filed 12/9/08 have been fully considered but they are not persuasive.

Applicant has argued that Takano cannot be used as a base reference in the prior art 35 USC 103 rejection. Takano is a secondary reference and is not the base reference. TEAS is the primary reference or base document, not Takano. The argument is not persuasive. Also, the argument is simply attaching Takano individually and is not taking into account the 103 combination of record. With respect to the argument that there is no indication in Takano that there is a order message that constitutes a legal acceptance of a trade mark, it is noted that the actual content of the message itself is directed to non-functional descriptive material as well as what the message constitutes. What the invention constitutes in an abstract sense (e.g. a legal acceptance) is not further limiting to the fact that there is a filing receipt that is evidence of receipt of a document by an intended recipient as is disclosed by Takano.

With respect to the arguments in view of Lee, they are not persuasive. The argument that combining Lee with TEAS would involve an increase in forms and data used and would it would be too complex to allow a filing in a single user session, this is not a sufficient reason to find that the limitation is not obvious. Just because something may be more complex (which is not admitted in this rebuttal) does not mean that it is not obvious. Updating old methods by using modern computers adds complexity to the entire process, but use of machines to update or modernize a method is surely an obvious thing to do, as has previously been held. The argument that combining them

together would not solve a problem it would create new problem is not a persuasive argument. Applicant's arguments are not persuasive with respect to Lee.

The argument that using the receipt of Takano with TEAS would risk an unexpected result is not a standard by which non-obviousness can be shown. The argument that using a receipt as is disclosed by Takano would result in the user being confused because of receiving a filing receipt for a patent when they filed a trademark, totally disregards the fact that TEAS (trademarks not patents) is modified by Takano to have a receipt showing proof of receipt of a filing for a trademark. The rejection did not change the fact that trademarks are being used in TEAS which is the base reference. This argument is taking an improper interpretation of the rejection and an unreasonable reading of Takano into TEAS. The argument is not persuasive. The rejection is providing the trademarks filing system of TEAS with a filing receipt feature for the trademark filing, not for a patent filing. Takano teaches the desirability of having a receipt that shows a document was received. This teaching is not only limited to draft documents but is applicable to any document, especially something as important as a trademark filing.

Applicant has argued that undue experimentation is involved, see page 37. Applicant must explain why and provides an analysis for the examiner to consider; otherwise, this is nothing more than a general allegation with no supporting facts or analysis to support what has been asserted.

With respect to the non-functional descriptive material finding, the conclusion and position of the examiner remains the same.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/  
Primary Examiner, Art Unit 3689